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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,414	10/12/2000	Howard J. Glaser	STL920000091US1	1232.

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INTERNATIONAL BUSINESS MACHINES CORP  
IP LAW  
555 BAILEY AVENUE , J46/G4  
SAN JOSE, CA 95141

EXAMINER
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GROSS, KENNETH A

ART UNIT	PAPER NUMBER
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2122

DATE MAILED: 05/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/687,414

Applicant(s)

GLASER ET AL.

Examiner

Kenneth A Gross

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-4 of copending Application No. 09/687,412. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 1-4 of the copending application No. 09/687,412 corresponds directly with Claim 1 of the current application. The current application teaches downloading an application program whereas the copending application No. 09/687,412 teaches updating an application program. It would be obvious that the current application also is used for updating, since downloading an application program often includes downloading the latest version of a current application, or downloading updates.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented

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3. Claims 1-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending Application No. 09/687,033. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 1 and 2 of the copending application No. 09/687,033 correspond directly with Claim 1 of the current application. Although the current application teaches downloading an application program whereas the copending application No. 09/687,033 teaches installing the application program, Claim 4 of the current application does teach building the application program.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 4, 7, 10, 13, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenner (U.S. Patent Number 6,314,565) in view of Davis et al. (U.S. Patent Number 5,742,829).

In regard to Claim 1, Kenner teaches: (a) defining and storing a configuration of the application program corresponding to a particular user of the application program (Column 7, lines 5-12 and lines 17-32); (b) initiating a connection between the local and remote data

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processing systems in response to a user request (Column 9, lines 39-53); (c) and downloading data from the remote to the local data processing system according to a stored configuration (Column 8, lines 18-29). Kenner does not teach authenticating a user in response to a user request for the program. Davis, however, does teach user authentication prior to software being transmitted to the user system (Column 8, lines 56-66). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to define and store a client configuration, connect to the client and download data to the client corresponding to the configuration as taught by Kenner, where the user is authenticated before data can be downloaded, as taught by Davis, since this prevents unauthorized users from accessing data. Claims 7 and 13 correspond directly with Claim 1, and are rejected for the same reasons as Claim 1.

In regard to Claim 4, Kenner teaches building the application program according to a user configuration (Column 8, lines 30-41). Claims 10 and 16 correspond directly with Claim 4, and are rejected for the same reasons as Claim 4.

6. Claims 2, 5, 8, 11, 14, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenner (U.S. Patent Number 6,314,565) in view of Davis et al. (U.S. Patent Number 5,742,829) and further in view of Hsu (U.S. Patent Number 5,894,515).

In regard to Claim 2, Kenner and Davis teach the article of manufacture of Claim 1, and Kenner further teaches downloading data from the remote to the local data processing system according to a stored configuration (Column 8, lines 18-29). Neither Kenner nor Davis teach encrypting and storing the configuration in a manifest file nor do either teach decrypting the configuration in response to user authentication. Hsu, however, does teach encrypting data,

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authorizing a user, and in response to authorizing a user, decrypting the data (Column 1, lines 13-21). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to define and store a client configuration, connect to the client and download data to the client corresponding to the configuration as taught by Kenner, where the user is authenticated before data can be downloaded, as taught by Davis, and the configuration is encrypted and decrypted in response to user authentication as taught by Hsu, since this protects the configuration from being view from unauthorized users. Claims 8 and 14 correspond directly with Claim 2, and are rejected for the same reasons as Claim 2.

In regard to Claim 5, Hsu teaches decrypting data (Column 1, lines 13-21) and Kenner teaches building the application program according to a user configuration (Column 8, lines 30-41). Hsu does not explicitly teach authenticating a user in response to a request for application build, however, since the information is encrypted, in order to build the application, it must be decrypted by a decryption process on the local computer system. Thus, this decryption acts as an authentication process, since only an authorized user knows the decryption process. Claims 11 and 17 correspond directly with Claim 5, and are rejected for the same reasons as Claim 5.

7. Claims 3, 6, 9, 12, 15, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenner (U.S. Patent Number 6,314,565) in view of Davis et al. (U.S. Patent Number 5,742,829) and further in view of Hsu (U.S. Patent Number 5,894,515) and Hayes, Jr. (U.S. Patent Number 6,205,476).

In regard to Claim 3, Kenner, Davis, and Hsu teach the article of manufacture of Claim 2, and further teaches: (a) storing the configuration in a manifest file (Column 7, lines 8-12 and lines 17-32); (b) downloading data from a remote data processing system according to the

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configuration (Column 8, lines 18-29 and Figure 3). Kenner does not teach encrypting the configuration, authorizing a user in response to a user request for the application program, and decrypting the manifest file to produce a decrypted configuration. Hsu, however, does teach encrypting data, authorizing a user, and in response to authorizing a user, decrypting the data (Column 1, lines 13-21). Neither Kenner nor Hsu teach downloading the manifest file from the remote data processing system to the local data processing system. Hayes, however, does teach storing user-specific application configuration preferences, and transmitting the preferences to the local user system (Column 22, lines 55-59). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to define and store a client configuration, connect to the client and download data to the client corresponding to the configuration as taught by Kenner, where the user is authenticated before data can be downloaded, as taught by Davis, and the configuration is encrypted and decrypted in response to user authentication as taught by Hsu, where the client configuration is stored on the remote processing system and is downloaded to the local processing system, as taught by Hayes, since this allows for a more organized and more central repository of user application preferences. Claims 9 and 15 correspond directly with Claim 3, and are rejected for the same reasons as Claim 3.

In regard to Claim 7, Hayes teaches storing application program configurations and user permissions (Column 1, lines 58-63). Hayes further teaches storing user data (Figure 15). Claims 12 and 18 correspond directly with Claim 6, and are rejected for the same reasons as Claim 6.

### *Conclusion*

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13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Hendrickson et al (U.S. Patent Number 5,933,646) teaches storing a user personality file (Column 9, lines 38-50).

Win et al. (U.S. Patent Number 6,161,139) teaches user authentication and a registry server with encrypted information.

Kroening et al. (U.S. Patent Number 6,080,207)

Manduley (U.S. Patent Number 5,956,505)


Walden, Jr. et al. (U.S. Patent Number 6,052,531)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth A Gross whose telephone number is (703) 305-0542. The examiner can normally be reached on Mon-Fri 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A Morse can be reached on (703) 308-4789. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

KAG  
May 8, 2003

  
GREGORY MORSE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100



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